

REMARKS

This Amendment is submitted in response to the Office Action dated 20 July 2004, the time to respond being until 20 October, 2004. Reconsideration and allowance of this application are respectfully requested. Claim 1 is amended, and claims 2 and 10-20 are canceled. Claims 1 and 3 through 9 remain pending in the application.

The Examiner objected to the disclosure because in the Brief Description of the Drawings, line 12, "Fig.2" should be -Fig.3--. The Specification is herein amended to amend FIG. 2 on line 12 of the Brief Description of the Drawings to FIG. 3.

The Examiner rejected Claims 1 and 3-5 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,531,562 to Eve in view of U.S. Patent No. 5,772,484 to Sikorski. According to the Examiner, Eve '562 discloses the invention substantially as claimed with the exception of the float ring being of closed-cell polyethylene foam, and that Sikorski '484 teaches a floatation device made of closed-cell polyethylene foam, and it would have been obvious to one skilled in the art to modify the system of Eve by using the floating ring of Sikorski. Applicant respectfully disagrees.

The Eve '562 patent discloses a floating support for growing plants that includes potting soil [col.1, line 24]. The Examiner contends that "potting soil" will inherently contain some clay. Applicant disagrees with this inherency argument. The object of the present invention is a self-watering planting system that remains floating in the water and keeps the plants moist. The present invention achieves this with alternating layers of clay and potting soil, the number of layers of each varying, depending upon the desired float depth. [page 9, lines 19 through 25; Figs. 5 and 6.] The discrete layers of clay have distinct properties, most importantly, their ability to retain moisture for ballast [page 9, lines 8 through 10], retain fertilizer in the soil, and add

minerals. Calcined montmorillonite clay is fired in special kilns into a form that's hard and stable but highly porous. Because the particle size is big, calcined montmorillonite clay also drains well (unlike raw clay).

An essential feature of the present invention is the combination of a particular fill (calcined montmorillonite clay in alternating layers) with a floating island planter to yield a self-watering yet buoyant system. The Examiner contends that potting soil inherently has clay, but no evidence is given in support. The Examiner has failed to make a *prima facie* case for inherency.

Moreover, applicant points out there are many varieties of potting soil, a few having clay and many that do not. None use calcined montmorillonite clay in alternating layers because none are designed for a floating island planter. Claim 1 is herein amended to recite: "...a fill mix residing in said planter, said fill mix comprising *alternating layers of calcined montmorillonite clay* and potting soil..." to further clarify the above-described distinguishing features. Eve does not disclose alternating layers of clay and potting soil at all, let alone calcined montmorillonite clay as taught by the present invention.

Furthermore, the Examiner combines Sikorski '484, and contends that Sikorski teaches a flotation device made of closed-cell polyethylene foam and it would have been obvious to modify the system of Eve by using the floating ring of Sikorski. Applicant respectfully disagrees. The present invention teaches a floating island planting system directed to keeping plants moist and alive while floating in ponds and water gardens. Sikorski, on the other hand, teaches a flotation toy device, i.e., a water toy used for recreation, and as such, is non-analogous art. Analogous Art is that which is "reasonably pertinent to the particular problem with which the inventor is involved." Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc., 21 F.3d 1068, 1072; 30 USPQ2d 1377, 1379 (Fed. Cir.1994). The goal of the present invention

(maintaining a water garden) has nothing to do with water toys, and Sikorski is simply not analogous art in this case.

Even if Sikorski was pertinent, obviousness can only be established by showing that “there must have been a reason, suggestion, or motivation to lead an inventor to combine [the] prior art references.” *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1572-73 (Fed. Cir.1996). The suggestion to do so may come expressly from the references themselves, implicitly from the prior art where the technology is relatively straightforward, from the knowledge of those skilled in the art, or from the nature of the problem to be solved. *See id.*; *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025 (Fed. Cir. 1985), (overruled on other grounds by *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356 (Fed. Cir. 1999)); *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed.Cir. 1997). Improvement over prior art, even though it be simple or involves only a reversing of certain parts, is patentable unless prior art shows that improvement is obvious.” In re Rothermel, 47 Cppa 866, 870; 276 F.2d 393, 396; 125 USPQ 328, 331 (1960).

The invention of amended Claim 1 is patentably distinguished for the reasons described above, particularly in light of Eve’s single layer potting soil and Sikorski’s floatation toy device. Applicant maintains that there is no teaching, suggestion, or motivation at all to combine the teachings of Eve and Sikorski as their design goals and methods are so divergent, and in any case the combination falls short of the new limitations in amended claim 1.

Claim 2 is herein canceled. Claims 3 through 5 are depending from Claim 1, include the same above-described limitations, and are thus likewise patently distinguished.

The Examiner had rejected Claim 2 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,531,562 to Eve in view of U.S. Patent No. 5,772,484 to Sikorski in further

view of U.S. Patent No. 4,219,349 to Bardsley. Bardsley '349 teaches plant nutrient compositions, methods and processes, that include a calcined montmorillonite clay. However, as noted above, the present invention teaches the layering of potting soil and calcined montmorillonite, which is particularly suited for a floating island plant system due to the clay substrate's ability to attract and hold on to nutrients in the planting system lowers the nutrient levels in the surrounding water, which in turn improves the quality of the surrounding water by making it less prone to algae growth. [page 9, lines 13-15] Neither the layering of the clay and soil nor the particular benefits to a floating plant system are taught or suggested by Bardsley.

The Examiner rejected Claims 8 and 9 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2,531,562 to Eve in view of U.S. Patent No. 5,772,484 to Sikorski in further view of FR 1566219. According to the Examiner, Eve in view of Sikorski, discloses all the claimed subject matter of Claims 8 and 9 except for the addition of carbon black to polyethylene to protect from UV damage as taught by FR 1566219. Applicant respectfully disagrees. Claims 8 and 9 are depending from Claim 1, include the same above-described limitations, and are thus likewise patently distinguished. Moreover, Claims 8 and 9 are distinguished on their own merits as Bardsley '349 teaches polyalkene stabilizers, including use with carbon black to protect against UV radiation. The title of the present invention is "Floating Island Planting System". The floating island structure is essential; throughout the specification. The stated objects of the present invention are "to provide a self-watering, self-feeding, anti-algae environment that will foster the growth of a wide range of aquatic and non-aquatic plants" and "to achieve proper float as well as to prevent algae blooms, feed the plants and condition the surrounding water". These objects are only possible through the floating island planting system detailed therein, and the inclusion of carbon black is simply not obvious.

With references that are entirely unconcerned with the goals of the present invention (i.e., the floating toy of Sikorski, the calcined clay of Bardsley and the carbon black of FR 1566219), the Examiner has resorted to piecemeal combining of individual features of prior art and runs afoul of the basic mandate inherent in Section 103 – that piecemeal reconstruction shall not be the basis for a holding of obviousness. In re Rothermel, 47 CCPA 866, 870; 276 F.2d 393, 396; 125 USPQ 328, 331 (1960). “Improvement over prior art, even though it be simple or involves only a reversing of certain parts, is patentable unless prior art shows that improvement as obvious.” Id. The present invention is a specific type of plant system, a floating plant system, particularly designed for floating in water and growing and maintaining plants in an aquatic environment.

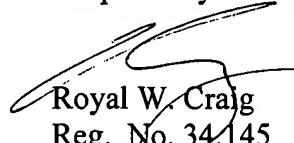
The Examiner objected to Claims 6 and 7 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates this but respectfully declines to amend Claims 6 and 7 at this time because Applicant believes that with the above amendments and remarks, Independent Claim 1 is now in the proper condition for allowance, but Applicant reserves the right to amend Claims 6 and 7 should the Examiner maintain his rejections.

* * * * *

Application of: Schuck, Richard.
Appln. No. 10/612,157
Page 11

In view of the above amendments and remarks, it is believed that this application is now in the proper condition, and a Notice of Allowance is respectfully requested.

Respectfully submitted,



Royal W. Craig
Reg. No. 34,145
(410) 385-2383
Attorney for Applicant

Date October 7, 2004

Law Offices of Royal W. Craig
10 North Calvert Street
Suite 153
Baltimore, Maryland 21202